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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)
		Application Number
		10/825,490
		Filed
		April 15, 2004
First Named Inventor		JOHNSON
Art Unit		3714
		Examiner
		Matthew D. Hoel
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> Applicant/Inventor</p> <p><input type="checkbox"/> Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> Attorney or agent of record 31,097 (Reg. No.)</p> <p><input type="checkbox"/> Attorney or agent acting under 37CFR 1.34. Registration number if acting under 37 C.F.R. § 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*</p> <p><input checked="" type="checkbox"/> *Total of 1 form/s are submitted.</p>		

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November 25, 2009

Date

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ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 40, 42-43, 46, 48-51, 54-59, 82-84, and 87-90 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Brosnan et al. in view of Astaneha, and further in view of Ungaro et al. This rejection should be reversed for at least the following reasons.

Certain exemplary embodiments of the claimed invention provide for first and second games of chance playable on a single gaming device/system, with at least the first game of chance being a live game of chance playable on a table with a live dealer, and with a second game of chance being playable by a player, while at the table, via a second game play area thereon. A player may wager on either or both of the first and second games of chance from the single gaming device. As claim 40 makes clear, the first game outcome and the second game outcome are independent of each other, and the first and second game outcomes are not combined to provide an outcome separate from the first and second same outcomes. Claim 40 also makes clear that a player may wager on either or both of the first and second games of chance from the gaming device, such that the player may wager on the second game of chance at least while the live first game of chance is being played, e.g., to address the desire to have games that are more exciting and stimulating, for example, by providing players with additional betting opportunities during a single game, to have several bets or games going at the same time so that if one game loses another may win, etc. The alleged Brosnan/Astaneha/Ungaro combination does not render obvious the pending claims, at least because it fails to teach or suggest an arrangement including these features of claims 40, or the analogous features of claims 56 and 82.

The Final Office Action mainly argues how Brosnan and Astaneha can be combined without actually stating why one skilled in the art would have made the combination. The test for obviousness is not whether the features of multiple references can be bodily incorporated into one another -- which, in this case, could not, and would not, have been done. Rather, the test is what the references as a whole would have suggested to one skilled in the art at the time of the invention. Thus, even if the Final Office Action had demonstrated that all of the limitations of the claims were taught or suggested by the prior art of record (which it most certainly has not done), simply stating that it would have been possible to combine the references falls short of providing a clearly articulated reasoning to support the legal conclusion of obviousness. Because the Final Office Action still has not clearly articulated why one of ordinary skill in the art at the time of the invention would have been led to the claimed invention, Applicant respectfully submits that the burden of establishing a prima facie case of obviousness has not yet been met.

First, Brosnan does not disclose a table game (i.e., it does not disclose poker, blackjack, etc.). Rather, Brosnan relates exclusively to electronic gaming machines, i.e., slot machines, video poker, etc. Those skilled in the art recognize that gaming machines are not table games. Although an electronic gaming machine may be horizontally oriented, e.g., when it is installed in a bar or at a table, it still is not a table game. Orienting a gaming machine horizontally does not make it a table game. A gaming machine is a gaming machine (and not a table game) regardless of whether it is vertically or horizontally oriented. The Final Office Action apparently does not appreciate this difference between gaming machines (e.g., slot machines) and table games (e.g., poker, blackjack, and other table games). Bridging the longstanding gap between the two so as to provide completely separate games thereon was not known prior to Applicant's disclosure.

Second, the citation to *Leapfrog* to argue that applying Brosnan's horizontal video displays to Astaneha's table is an automation of known manually played games is inapposite. Applicant has not claimed an "electronic" or otherwise "automated" version of a table game. Instead, claim 40 calls for "a table having a horizontal top surface configured to enable a player to play a live first game of chance . . . [and] a second game play area configured to enable the player to play . . . a second game of chance . . . wherein the first game outcome and the second game outcome are independent of each other, [and] wherein the player may wager on either or both of the first and second games of chance from the gaming device, such that the player may wager on the second game of chance at least while the live first game of chance is being played." Neither Brosnan nor Astaneha, nor the alleged combination of the two, teach or suggest such an arrangement. Nor would one of ordinary skill in the art at the time of the invention have achieved this claimed arrangement by simply "automating" Astaneha in the manner purportedly taught by Brosnan.

Pages 13-14 of the Final Office Action attempt to overcome this deficiency by refusing to give patentable weight to the above-identified claim language under the rationale that it somehow is "intended use" language -- despite the MPEP mandate that all claim limitations must be considered. The above-identified language clearly relates to the functionality of the gaming method of claim 40. This language unambiguously establishes how the method is to be practiced. The fact that, in use, a player may opt to play a first game of chance, or a second game of chance, or both first and second games of chances does not mean that this language can be ignored. Expressly recited functional aspects are tied to expressly recited structure to establish how the claim is to be practiced -- which is entirely appropriate for a method claim.

Third, the Final Office Action incorrectly alleges that Brosnan's purported teachings of different games appearing to interact with one another is analogous to the wagers of the combinations of games outlined in Astaneha. Brosnan makes clear in the very portions cited in the Final Office Action that although "the game outcome presentations for two or more of the games may appear to interact" (emphasis added), "the game outcomes determined by the gaming machine are independent of one another and do not depend on the game outcome presentation" (emphasis added). Any interactions between the game outcome presentations in Brosnan thus appear to be nothing more than mere visual flourishes designed to add interest and excitement to the gaming scenario -- but they do not to add any substantive interaction between, or make any substantive combination with, the games. The Final Office Action errs in arguing that these portions of Brosnan -- which teach that the different game outcome presentations may appear to interact with one another -- have anything to do with wagering on a combination of games.

Furthermore, as has been well established, Astaneha does not teach separate games having separate game outcomes or wagering on a combination of games. Astaneha teaches a single game that incorporates the elements of numerous different games -- including a roulette wheel, dice, and cards. Astaneha merely teaches a single game with multiple game elements. While a player may bet on the single game in a plurality of different ways (e.g., using Astaneha's plural wagering areas), such is no different from conventional games that allow players to make different wagers on a single game. Indeed, a player playing blackjack may double up, double down, or make any number of other bets. What Astaneha adds is a plurality of different gaming elements that can be wagered on as a part of its single game. What Astaneha is very clear about not adding is wagering on a combination of different games. The features of Brosnan properly described above are not "analogous" to this functionality of Astaneha. Even if there were, once again, such is not called for in Applicant's claimed invention or relevant to any claim features.

The examples provided in the Final Office Action do little to support the proposition that Brosnan's purported teachings of different games appearing to interact with one another is analogous to the wagers of the combinations of games outlined in Astaneha. The examples also are unrelated to the claimed invention. With respect to the successive pachinko/bonus slot game example, Applicant again points out that the outcome of the bonus slot game is dependent on the base pachinko game, at least insofar as a player would not reach the bonus slot game without playing the base pachinko game. That is, the game outcome of the base pachinko game determines whether a bonus slot game will be made available and, thus, whether there will be a

bonus slot game that has its own game outcome. The game outcomes of the base pachinko game and the bonus slot game are independent of one another only to the extent that they are calculated independently of one another. However, the game outcomes cannot be said to be independent of one another, since the bonus slot game is only “launched” in dependence on the outcome of the base pachinko game. This is the antithesis of that which is claimed -- namely, first and second games of chance that are playable independently of one another and that have game outcomes that are independent of one another.

Astaneha does not disclose “parallel games.” Astaneha discloses a single game with a variety of game elements taken from different types of games. The wagering on the particular elements may vary but, fundamentally, only one game is ever played at a time. Even if one were to erroneously equate the single-game-multiple-elements teachings of Astaneha with “parallel games,” such still would not correspond to Brosnan or the claimed invention. That is, such would not correspond to Brosnan because the pachinko/bonus slot game example requires games being played “in serial” as opposed to “in parallel.” Such would not correspond to the claimed invention because the alleged “parallel games” of Astaneha would all depend on the particular combination of elements wagered on, with the combination of the individual elements being linked together and thus not independent of one another.

Thus, the so-called “modes of play” in Brosnan, Astaneha, and the claimed invention all markedly differ. One of ordinary skill in the art would recognize that neither Brosnan nor Astaneha disclose “the combination of two independent results.” One of ordinary skill in the art also would recognize that to the extent that Brosnan and Astaneha could be considered to disclose “the combination of two independent results,” such is not called for in the claims.

Fourth, the Final Office Action seems to allege that it would be possible to create an electronic version of Astaneha. Applicant does not necessarily disagree. Indeed, Applicant previously pointed out that if one were to forcibly combine the teachings of Brosnan and Astaneha (which Applicant believes would not have been done), one of ordinary skill in the art at the time of the invention would have been led to an electronic version of Astaneha’s game. In other words, Astaneha’s game would be implemented on a gaming machine rather than on a live, specialized table. But implementing Astaneha’s game on a gaming machine -- with or without Brosnan’s teachings -- still is not the same as claim 40. Indeed, it actually is quite different from “a table having a horizontal top surface configured to enable a player to play a live first game of

chance having a first game outcome . . . [along with] a second game play area configured to enable the player to play, while at the table,” and the similar features recited in claims 56 and 82.

Once again, the Final Office Action misses the point: Applicant’s claimed invention is not concerned with a gaming machine implementation. Instead, it is concerned with (1) a live table having a live dealer for playing a live first game of chance, and (2) an independent second game of chance also being playable while at the table. Thus, creating an electronic version of Astaneha -- or any other type of game -- is unrelated to that which is claimed. And such would not result in an arrangement where a live first game and a separate second game could be played independently of one another, e.g., enabling a player to play the second game while waiting for the live action associated with the first game to “go around” so that it is the player’s turn again.

Fifth, the Final Office Action incorrectly argues that Brosnan discloses “live play.”

Brosnan does teach multiple players being connected to a gaming machine system, e.g., such that a bonus may be triggered for all of the players. But one skilled in the art would recognize that a “live game” is not the same as the distribution of bonus awards. For example, one skilled in the art would know that a “live game” is played with real players and real dealers at a real table, e.g., as called for in claim 40. One skilled in the art would know that a “live game” is unrelated to gameplay on an electronic gaming machine, once again, as called for in claim 40. Thus, one skilled in the art would know that Brosnan, which relates solely to electronic gaming machines, cannot disclose the type of live game called for in claim 40, at all. Moreover, one skilled in the art at the time of the invention would not have incorporated any “live” teachings of Astaneha into Brosnan for the reasons previously provided including, for example, the uncontroverted facts that there is (and has been) a fundamental difference between table games and gaming machines, and there are (and have been) difficulties tying the two together.

As shown above, the alleged combination of references fails to teach or suggest a number of features in claims 40, 56, and 82 (and their dependents), and the Final Office Action fails to establish why one of ordinary skill in the art would have been led to Applicant’s claimed invention. Furthermore, the Final Office Action is replete with errors regarding the scope and content of the prior art. Applicant thus submits that the alleged three-way Brosnan/Astaneha/Ungaro combination fails to render obvious claims 40, 56, and 82 (and their dependents).

The introduction of Huard et al., Adams, and/or Pohanka fails to make up for the above-noted fundamental deficiencies with the alleged Brosnan/Astaneha/Ungaro combination.

Withdrawal of all rejections and allowance of this application thus are earnestly solicited.